



Attorney Docket No. 12504US04

UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Castellani et al.

Serial No. 10/715,942

Filed: November 18, 2003

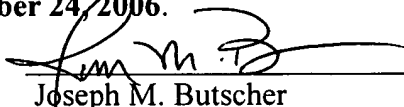
For: QUAD RECEPTACLE, DUAL CIRCUIT
FLUSH POKE-THROUGH WIRING
FITTING WITH INTERNALLY
MOUNTABLE
COMMUNICATION/DATA JACKS

Examiner: Dhiru Patel

Group Art Unit: 2831

CERTIFICATE OF MAILING

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October 24, 2006.


Joseph M. Butscher
Reg. No. 48,326

3rd PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. **No fee is believed due with respect to the Notice of Appeal because the Applicants previously paid the fee** when the first Notice of Appeal was filed on August 3, 2005. **See MPEP § 1207.04.**

The review is requested for the reasons stated on the attached sheets

Respectfully submitted,

Date: October 24, 2006

By: 

Joseph M. Butscher

Reg. No. 48,326

Attorney for Applicants

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REMARKS

The present application includes pending claims 1-28, all of which have been rejected. Reconsideration of the claim rejections is requested.

On January 4, 2006, the Examiner issued a Final Office Action with respect to the application. On February 15, 2006, the Applicants filed a Notice of Appeal and Pre-Appeal Brief Request For Review. **A reviewing panel responded by reopening prosecution.** *See* March 13, 2006 Notice of Panel Decision (reopening prosecution). **This was not the first time prosecution was reopened in response to a Notice of Appeal and Pre-Appeal Brief Request For Review.** *See* August 3, 2005 Notice of Appeal and Pre-Appeal Brief Request For Review; *see also* September 14, 2005 Notice of Panel Decision (reopening prosecution).

The present application was filed November 18, 2003, and has gone through extensive prosecution. As noted above, two previous Pre Appeal Brief Requests for Review resulted in prosecution being reopened. Considering the long pendency of the present application, and the fact that prosecution has been reopened twice in response to two previous Pre Appeal Brief Requests for Review, the Applicants respectfully request that the Panel allow the pending claims after considering this **Third** Pre Appeal Brief Request for Review, for at least the following reasons:

Despite the two previous final rejections and Panel Decisions reopening prosecution, the March 13, 2006 Office Action and the July 17, 2006 Final Office Action both rely on previously asserted grounds for rejection and on a previously cited reference. Namely, that the claims of the present application are anticipated, or rendered obvious, by United States Patent No. 6,114,623 to Bonilla et al. ("Bonilla").

Bonilla was cited two years prior in a March 17, 2004 Office Action rejecting all of claims 1-28. *See* March 17, 2004 Office Action. Bonilla was withdrawn, however, after the Applicants amended certain claims in a June 14, 2004 Response to that office action and an October 6, 2004 response to a subsequent August 6, 2004 Office Action. *See* November 2, 2004 Office Action (not citing Bonilla). Bonilla then resurfaced in the March 13, 2006 Office Action after two years, two final rejections, and two re-openings of prosecution by the Panel.

In a response to the March 13, 2006 Office Action, Applicants explained in depth why the pending claims are patentable over Bonilla by itself, or in combination with United States Patent No. 6,417,446 to Whitehead (“Whitehead”). *See* April 10, 2006 Response at pages 3-9. The July 17, 2006 Final Office Action, however, maintains the exact same rejections and bases for rejections. *See generally* July 17, 2006 Final Office Action. Notably, all of the rejections rely in whole or in part on Bonilla, **the very reference which was withdrawn over two years ago after Applicants amended the claims.**

I. Claims 1-2, 4-7, 9-11, 13-14, 18, 20-22, And 24-26 Are Not Anticipated By Bonilla

Claims 1-2, 4-7, 9-11, 13-14, 18, 20-22, and 24-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bonilla. July 17, 2006 Office Action at pages 2-6. Bonilla does not, however, anticipate these claims at least because Bonilla does not describe, teach, or suggest that each simplex power receptacle includes a respective housing. *See* September 13, 2006 Response at pages 9-10. Moreover, there is no requirement to describe a “criticality” of a claim term, nor does the Office Action cite any law to support such a proposition. *See* July 17, 2006 Office Action at page 20 and September 13, 2006 Response at page 9. Thus, for at least these reasons, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation.

II. The Proposed Combination Of Whitehead And Bonilla Does Not Render Claims 1-28 Unpatentable

Claims 1-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Whitehead in view of Bonilla. *See* July 17, 2006 Office Action at pages 7-19.

A. The Proposed Combination Of Whitehead And Bonilla Does Not Disclose Or Suggest Four Simplex Power Receptacles Each Having Its Own Respective Housing As Specified By Claims 1-28

Independent claims 1, 6, 11, 14, 16, 18, 21, 26, and 27 specify four simplex power receptacles, each having its own respective housing, a feature that is neither disclosed nor suggested by the proposed combination of Whitehead and Bonilla. *See* September 13, 2006 Response at pages 10-11. For at least this reason, the Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claims 1, 6, 11, 14, 16, 18, 21, 26, 27, and the claims that depend therefrom.

B. The Proposed Combination Of Whitehead And Bonilla Does Not Disclose Or Suggest Four Communication/Data Jacks Being Arranged In A Longitudinal Row As Specified By Claims 16-17 and 27-28

Independent claims 16 and 27 specify four communication/data jacks being arranged in a longitudinal row, a feature that is neither disclosed nor suggested by the proposed combination of Whitehead and Bonilla. *See* September 13, 2006 Response at pages 11-12. For at least this reason, the Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claims 16, 27, and the claims that depend therefrom.

C. The Proposed Combination Of Whitehead and Bonilla Is Improper

Whitehead and Bonilla cannot be combined without running afoul of their stated purposes. *See* September 13, 2006 Response at pages 12-15. Thus, for at least this reason, the

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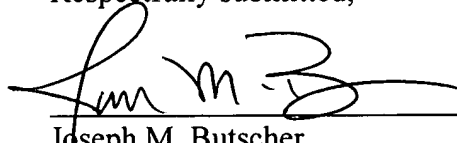
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Applicants respectfully submit that the proposed combination is improper, and, therefore, a *prima facie* case of obviousness has not been established.

III. Conclusion

In view of the above, the Applicants respectfully submit that claims 1-28 are in condition for allowance. The Applicants respectfully request that the Panel **allow the pending claims**, especially after considering the long pendency of the present application, the extensive prosecution, and the previous decisions to reopen prosecution in response to two earlier Pre Appeal Brief Requests for Review. **No fee is believed due with respect to the Notice of Appeal because this fee was previously paid in connection with the August 3, 2005 Notice of Appeal.** The Commissioner is authorized, however, to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,



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